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FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER

LU, KUEN S

ART UNIT PAPER NUMBER

2167

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/871,094

Applicant(s)

SATO ET AL.

Examiner

Kuen S. Lu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-18, 20-23 and 25-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-18, 20-23 and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

RD

DETAILED ACTION

Response to Amendments

1. The Action is responsive to the Applicant's Amendments, filed on April 18, 2005.
2. The Applicant's amendments made to claims 16 and 21 for correcting informalities is noted and the Examiner's objection is hereby withdrawn.
3. Also noted is the Applicant's amendments made to claims 16 and 21, where the following new issue was raised when the limitations "wherein said information processing system automatically stores said electronic mail sender information if said electronic mail sender information is sent from an unknown electronic mail sender" was amended to claim 16 and "wherein said electronic mail sender information is automatically stores if said electronic mail sender information is sent from an unknown electronic mail sender" was amended to claim 21. The Examiner has introduced new reference to provide teaching for the amended disclosures, in the Office Action for Final Rejection (hereafter "the Action") as shown next.
4. Concerning the Applicant's Remarks on claim rejections, filed on April 18, 2005, has been fully considered by the Examiner, please see discussion in the section ***Response to Arguments***, following the Action.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 16-17, 20-22 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over CASK (Japan Patent JP-11149434, English Abstract and Japanese Patent Drawing, hereafter "CASK") in view of Maquaire et al. (U.S. Publication 2002/0107049, hereafter "Maquaire") and Cooper et al. (U.S. Patent 6,052,442, hereafter "Cooper").

As per Claims 16 and 21, CASK teaches "receiving an electronic mail containing electronic mail sender information" (See the Abstract wherein CASK's the electronic-mail addresses of the calling party are received by the electronic-mail receiver and the calling party is recognized immediately is equivalent to Applicant's receiving an electronic mail containing electronic mail sender information); "reading a lookup table including electronic mail account information" (See the Abstract wherein CASK's the electronic-mail receiver receives the electronic-mail addresses of the calling party, an alarm sound is designated to each of the electronic-mail addresses and the calling party is recognized immediately is equivalent to Applicant's reading a lookup table including electronic mail account information); and an alarm "corresponding to said electronic mail account information" (See the Abstract wherein CASK's an alarm sound is designated to each of the electronic-mail addresses and the calling party is

recognized immediately and the sound is output is equivalent to Applicant's an alarm corresponding to said electronic mail account information).

CASK does not specifically teach, instead of an alarm sound, "a music file" corresponding to each electronic mail account information and "a title and an artist associated with the music file".

However, Maquaire teaches receiving an incoming call, deriving the originating number, comparing the number to the numbers in a database, accessing the audio file corresponding to the matched number, playing the audio file and displaying the name and number to the user (See Figs. 2-4, Page 2, [0023] and [0028]).

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Maquaire's teaching with CASK's by using audio file to identify the incoming electronic mail and further displaying the audio file title and artist data while playing the file because both references are devoted to ordinary folks' daily, popular and routine communication and to the identification of the originating party of the communication, and the combined teaching would have enabled CASK system's users more completely and efficiently to identify the sender of electronic mail via the notes, title and artist of the audio media.

The combined Maquaire-CASK reference further teaches "retrieving said music file corresponded to said electronic mail account information of said electronic mail sender information received" (See CASK: in the Abstract where an alarm sound corresponding to each incoming electronic address is retrieved, and Maquaire: at Page 2, [0028] where audio file corresponding to an incoming call is retrieved).

Furthermore, the combined Maquaire-CASK reference teaches “when the electronic mail has been received, for causing the retrieved music file to be reproduced and for causing a signal to be supplied to a display means representative of the respective title and artist such that the retrieved music file is reproduced simultaneously or substantially simultaneously with the display of the respective title and/or artist” (See CASK: in the Abstract where the calling party is immediately recognized and an alarm sound corresponding to the incoming electronic address is retrieved and output, Maquaire: at Figs. 2-4, Page 2, [0023] and [0028] where teaches receiving an incoming call, deriving the originating number, comparing the number to the numbers in a database, accessing the audio file corresponding to the matched number, playing the audio file and displaying the name and number to the user, and the combined reference: suggesting to display audio file title and artist).

The combined teaching of Maquaire and CASK references does not specifically teach “wherein said electronic mail sender information is automatically stores if said electronic mail sender information is sent from an unknown electronic mail sender”.

However, Cooper teaches “wherein said electronic mail sender information is automatically stores if said electronic mail sender information is sent from an unknown electronic mail sender” (See Fig. 4 and col. 9, lines 40-65 wherein Cooper’s automatically storing email sender and unknown telephone number suggests teaching of automatically storing electronic mail sender information if said electronic mail sender information is sent from an unknown electronic mail sender).

It would have been obvious to one having ordinary skill in the art at the time of the

applicant's invention was made to combine Cooper's teaching with the Maquaire and CASK references by automatically storing unknown email sender and unknown telephone number in the communication system because all references are devoted to ordinary folks' daily communication and combined teaching would further help users to conveniently playing back or displaying back voice and text messages as desired simultaneously on the same communication system.

As per Claims 17 and 22, the combined teaching of Cooper, CASK and Maquaire references further teaches electronic mail account information in said lookup table is an electronic mail sender account (See CASK: an alarm sound is corresponding to each incoming electronic mail address, and Maquaire: Fig. 4, and Page 2, [0028] where database table provides audio file to corresponding incoming call number data).

As per Claims 20 and 25, the combined teaching of Cooper, CASK and Maquaire references further teaches "lookup table is set up in advance" (See Maquaire: Page 2, [0028] by showing database table having numbers ready for being compared to the incoming number).

7. Claims 18 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over CASK (Japan Patent JP-11149434, English Abstract and Japanese Patent Drawing, hereafter "CASK") in view of Maquaire et al. (U.S. Publication 2002/0107049, hereafter

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"Maquaire") and Cooper et al. (U.S. Patent 6,052,442, hereafter "Cooper"), as applied to claims 16 and 21 above, and further in view of Toyoda (U.S. Patent 6,441,916).

As per Claims 18 and 23, the combined teaching of Cooper, CASK and Maquaire references teaches an electronic mail system playing audio file corresponding to each sender as previously described in claims 16-17 and 21-22 rejection.

The combined teaching of Cooper, CASK and Maquaire references does not specifically teach "electronic mail account information in said lookup table is a domain name in said electronic mail sender account".

However, Toyoda teaches "electronic mail account information" is a domain name in said electronic mail sender account at col. 5, lines 50-60 by showing the domain name mgcs.co.jp.

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Toyoda's teaching with the already combined teaching of Cooper, Maquaire and CASK references by including domain name into the account information because network is a platform utilized by all references and the further combined teaching would have enabled CASK's system to send and receive electronic mails to and from all users in the WAN, as evidenced by the Patent Drawing, Page 16, Figure 1.

8. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over CASK (Japan Patent JP-11149434, English Abstract and Japanese Patent Drawing,

hereafter "CASK") in view of Maquaire et al. (U.S. Publication 2002/0107049, hereafter "Maquaire") and Cooper et al. (U.S. Patent 6,052,442, hereafter "Cooper"), as applied to claims 16 and 21 above, and further in view of Hunter et al. (U.S. Publication 2002/0111912, hereafter "Hunter").

As per Claims 18 and 23, the combined teaching of Cooper, CASK and Maquaire references teaches an electronic mail system playing audio file corresponding to each sender and displaying the title and artist as previously described in claims 16-17 and 21-22 rejection.

The combined teaching of Cooper, CASK and Maquaire references does not specifically teach "the respective music file includes a picture file associated with the respective artist, and wherein the causing means causes the picture to be displayed on said display means when the electronic mail has been received".

However, Hunter teaches "the respective music file includes a picture file associated with the respective artist, and wherein the causing means causes the picture to be displayed on said display means when the electronic mail has been received" (See Fig. 10 and Page 7, [0080] where a multiple level of selecting audio files permits identification of specific artists and displaying artist's picture).

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Hunter's teaching with the already combined teaching of Cooper, Maquaire and CASK references by displaying audio file and its artist information, such as title, name and picture and the combined teaching would have enabled CASK system's users more completely and efficiently to identify the

sender of electronic mail via the notes, title, artist name and artist picture of the audio media.

9. The prior art made of record

A. U.S. Patent No. 6,441,916

B. U.S. Pub. No. 2002/0107049

C. U.S. Pub. No. 2002/0111912

N. Japan Patent JP-11149434, English Abstract and Japanese Patent Drawing

I. U.S. Patent No. 6,052,442

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

D. U.S. Patent No. 6,212,265

E. U.S. Patent No. 6,556,255

F. U.S. Pub. No. 2004/0030744

G. U.S. Patent No. 6,389,455

H. U.S. Pub. No. 2002/0166119

Response to Arguments

10. The Applicant's arguments filed on April 18, 2005 have been fully considered. As for the Examiner's response, please see discussion below.

a). At Pages 6-8, concerning claims 16 and 21, the Applicant argued that the Maquaire and CASK references, and their combined teaching do not teach "wherein

said electronic mail sender information is automatically stores if said electronic mail sender information is sent from an unknown electronic mail sender” as the limitation newly amended.

As to the above argument **a)**, the Examiner respectfully submits that the Cooper reference has been introduced to combined with the Maquaire and CASK references for providing the said disclosure. Please further refer to the respective section in the Action.

11. As to dependent claims (17-18, 20, 26) and (22-23, 25, 27), which directly or indirectly depend on independent claims 16 and 21, respectively, the Examiner applies the above stated arguments for the respective claim upon which they depend.

12. In light of the forgoing arguments, the 35 U.S.C. § 103 rejections for claims 16-18, 20-23 and 25-27 is hereby sustained.

Conclusions

13. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuen S. Lu whose telephone number is 571-272-4114. The examiner can normally be reached on 8 AM to 5 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Kuen S. Lu


Patent Examiner

June 5, 2005



Mohammad Ali

Primary Examiner

June 5, 2005